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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/764,029	01/22/2004	Carl Cetera	SS-108	7946
35693	7590	03/13/2006	EXAMINER	
THE SONI LAW FIRM 55 S. LAKE AVE SUITE 720 PASADENA, CA 91101			WALCZAK, DAVID J	
			ART UNIT	PAPER NUMBER

3751

DATE MAILED: 03/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/764,029

Applicant(s)

CETERA, CARL

Examiner

David J. Walczak

Art Unit

3751

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 January 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 and 13 is/are pending in the application.
- 4a) Of the above claim(s) 13 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☒ Claim(s) 6-10 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-5 remain rejected under 35 U.S.C. 102(b) as being anticipated by Hsieh. Hsieh discloses a writing instrument 20, a clip attached at an upper end thereof to the writing instrument wherein the clip comprises a track and comprised of two parallel metal wire rails 12 (see the last line of column 2) wherein the rails are connected at the lower end of the clip and a slidable member 30 having indicia thereon slidably articulated on the rails (during assembly, the member 30 is slid onto the rails).

Allowable Subject Matter

Claims 6-10 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

Applicant's arguments filed 1/26/06 have been fully considered but they are not persuasive. The Applicant contends that the Hsieh reference is not applicable against claims 1 and 3 in that element 30 is not slid onto the rails and is not slidably articulated on the rails as claimed. However, element 30 is described as having opening which

receive the ends of the rails. Accordingly, element 30 must be "slid" onto the rails during assembly and is thereby considered to be "slidably articulated" upon the rails. It is noted that "articulate" is defined by Webster as "to become united or connected" and clearly element 30 and the rails become united and connected. The Applicant further contends that the ferrule 11 blocks the sliding of the element 30 and that element 30 is "inserted into" the free ends (as opposed to slid onto the free ends) and thereby the Hsieh reference cannot be applied. However, element 30 is slid onto the two ends after the two ends have passed through the ferrule. The fact that future sliding is prevented from the ferrule is immaterial in that the claim merely calls for a slidable member sliding articulated onto the rail and does not define any future motion of the element. Further element 30 is clearly slid onto the rails (the rails are inserted into the holes in element 30) and not inserted into the rails, as the Applicant contends. Accordingly, the Hsieh device discloses the invention *as claimed*.

The Applicant further indicates that the article must remain slidable after the assembly is finished while the slidably element in Hsieh is fixed after assembly and therefore the Hsieh reference is not applicable. This feature, however, has not been claimed. The Examiner maintains that the Hsieh reference discloses the structure *as claimed*.

Lastly, the Applicant contends that the ends of the rails are not connected to the writing instrument, as claimed, and therefore the Hsieh reference is not applicable. The ends of the rail (i.e. the upper end of the clip), however, is connected to the instrument body (via element 11), i.e., the claim does not disclose that there is no intermediate

element between the clip and body but merely defines the "upper end of the clip connected with said elongated instrument body". As discussed above, the upper end of the clip in the Hsieh device is considered to be connected to the body via element 11.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David J. Walczak whose telephone number is 571-272-4895. The examiner can normally be reached on Mon-Thurs, 6:30- 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Justine Yu can be reached on 571-272-4835. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3751

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



David J. Walczak
Primary Examiner
Art Unit 3751

DJW
3/8/06